

REMARKS

This amendment is in response to a first Office action (Paper No. 5) mailed February 27, 2003. Upon entry of this amendment, claims 1, 2, 4-8 and 16-30 will be pending in this application. Applicant has canceled claims 3, 9-15 without prejudice or disclaimer as to their subject matter by this amendment, newly added claims 21-30 by this amendment and has amended claim 1 by this amendment.

In Paper No. 5, the Examiner has rejected claims 16, 17, 19 and 20 under 35 U.S.C. 103 (a) as being unpatentable over Ban *et al.*, U.S. Patent No. 6,148,354 or Sartore *et al.*, U.S. Patent No. 6,012,103 in view of Fukuzumi *et al.*, U.S. Patent No. 6,079,019. Applicant traverses this rejection.

Discussion of Ban '354 and Sartore '103 vis-a-vis Applicant's security feature

Ban '354 teaches a flash memory device that attaches to a USB port on a computer. Sartore '103 teaches a computer having a USB port and a USB peripheral that can be reconfigured without physically detaching the peripheral and then reattaching the peripheral to the USB port. The USB peripheral in Sartore '103 contains a memory that has an identification code to identify the peripheral device so that the host computer can download the appropriate configuration information to the peripheral device when the peripheral device is attached to the USB port of the host.

In Paper No. 5, the Examiner asserts that the identification code in Sartore '103 serves as a password to verify an authorized user. Applicant disagrees. Applicant submits that Sartore '103 does not teach or fairly suggest that the identification code can be a password that serves to verify

a user. This point is important because claim 16 claims "enabling a hard disk drive of said host computer if said security information in said USB device matches said security information in said host computer." Applicant submits that the identification code of Sartore '103 does not teach or suggest this limitation of claim 16 as Sartore '103 does not enable the hard disk drive of the host computer based on the identification code found in the USB peripheral.

Claim 20 was never Examined

Regarding claim 20, depending claim 20 claims "displaying an error message if said security information in said host computer does not match said security information in said USB device." In Paper No. 5, the Examiner does not address this limitation of claim 20. Therefore, Applicant submits that the Office action of Paper No. 5 is incomplete. This limitation of claim 20 is a vital aspect of Applicant's invention as claim 20 claims that the password check of the USB memory device is done prior to booting of the host computer and that the booting of the host computer is contingent upon the password found in the USB device. Applicant submits that these features are not taught nor suggested by any of the applied prior art.

Discussion of Fukuzumi '019 vis-a-vis Applicant's security feature

Fukuzumi '019 pertains to a PC card that has a memory. When the PC card is attached to the host computer, the password on the card is compared to the password on the host. If the passwords are matched, then 1) the host is allowed to write enciphered data into a memory on the PC card and 2) deciphered data from the memory on the PC card is allowed to be output to the host.

If the passwords do not match, then the PC card does not encipher data input from the host and does not decipher data read out from the PC card (see, for example col. 10, lines 30-45 of Fukuzumi '019). This, unlike Applicant's claimed invention, Fukuzumi '019 does not enable a hard drive in the host or boot the host in response to the password check. Further, the password check in Fukuzumi '019 occurs after the host is fully booted, not prior to when the host is booted as in Applicant's claimed invention. Further, Fukuzumi '019 pertains to a PC card while Applicant's claimed invention pertains to a USB compatible password key. Therefore, Applicant submits that Fukuzumi '019 does not teach, suggest or pertain to Applicant's claimed invention.

In Paper No. 5, the Examiner relies on Fukuzumi '019 to reject claims 16, 17, 19 and 20. The Examiner states "Fukuzumi discloses it is well known for IC memory card to contain password to be deciphered by the computer for security protection (col. 1, l 64 through col. 2, line 1)." Applicant submits that this is not what Applicant is claiming. Applicant is claiming that the hard drive is enabled and booting takes place if the security password on the card matches the security password stored on the host computer. Applicant is also claiming that an error message is displayed if the passwords do not match. Applicant further submits that these claimed features are neither taught nor suggested by the applied prior art.

Discussion of claim 18 vis-a-vis Shu '441 and other applied prior art

Regarding claim 18, claim 18 claims that the host is booted after the hard disk drive is enabled and when the passwords of the USM device and the host computer match. In Paper No. 5, the Examiner applies Shu, U.S. Patent No. 6,058,441 to reject claim 18. In Paper No. 5, the

Examiner states, "Shu (Fig. 2) discloses an apparatus hence a method of attaching a USB device to the host computer 20 and after verifying/modifying the settings, booting host computer in order to confirm that the software and hardware are correct (col. 4, ll. 44-66). Though not disclosed, it would have been obvious to one having ordinary skill in the art to modify the step of booting the host computer is necessary in order to confirm the correction of software and hardware as taught by Shu." Applicant submits that this is not what is claimed by Applicant.

In claim 18, Applicant claims that the host computer is booted after enabling the hard disk drive. This feature is not taught or suggested by Shu '441 or any of the applied prior art. Further, Applicant is claiming that the host is booted if the passwords match. However, none of the applied prior art teaches or suggests booting a host computer if the passwords match. In contradistinction, Shu '441 pertains to a system control operation that is used to change peripheral control information when the configuration of a multiport card is changed in an industrial control. Shu '441 does not pertain to security or enabling a host or booting a host if security clearance is passed. Similarly, neither Sartore '103, Ban '354 nor Fukuzumi '019 pertain to enabling a host computer after a positive password check. Because these applied references do not pertain to Applicant's claimed invention, the rejection to claims 16-20 must be withdrawn.

Discussion of the rejection of claims 10 and 15 (the sliding cover feature)

Regarding claims 10 and 15, Applicant claims that the USB memory device has a sliding cover. In claim 15, Applicant further claims that the cover slides in a backward direction automatically when the memory device is attached to the USB port of the host. In Paper No. 5, the

Examiner states, "Sliding cover is standard in floppy disks in order to protect data; it would have been obvious to one having ordinary skill in the art to implement commonly practice of having a sliding protection cover of floppy drive in flash memory card for the same reason of protecting data. Applicant disagrees.

First of all, Applicant is not claiming a *floppy* drive. Second, Applicant disagrees that it is common practice to have a sliding protection cover. For example, the standard 5 ¼ inch floppy does not have any protection cover.

Claim 15 was never examined in Paper No. 5

Regarding claim 15 which claims that the sliding cover slides backwards, the Examiner never addressed this issue in Paper No. 5 making Paper No. 5 incomplete. Further, it is noted that the 3 ½ inch diskette and zip disks have a sliding cover that slides *sideways*, not backwards. Therefore, Applicant submits that the features of claims 10 and 15 are not obvious over the applied prior art.

Applicant has canceled claim 15 by this amendment and incorporated the subject matter of claim 15 into apparatus claim 1 and method claim 30 by this amendment.

Discussion of Claim 9 and Moreau, USP 6,061,791

Claim 9 claimed the key ring feature. The Examiner, in Paper No. 5 used Moreau '791 to reject claim 9. Applicant has canceled claim 9 without prejudice or disclaimer as to its subject matter by this amendment making the rejection to claim 9 moot.

Discussion of newly added claims and amendments

Applicant has amended independent apparatus claim 1 by this amendment to claim the cover feature. Applicant submits that the applied prior art does not teach or suggest the cover feature of Applicant's USB memory device.


Applicant has newly added claims 21-30 by this amendment. Claims 21-24 depend from apparatus claim 1. These claims focus on the cover feature of Applicant's portable USB memory device.

Applicant has newly added method claim 25 and depending claims 26-30. These claims focus on the security password feature. These claims clearly indicate that the password check is done prior to booting of the host. Further, these claims claim that the booting of the host is contingent upon a successful password check. Claim 30 claims the cover sliding feature as discussed above. Entry of these newly added claims and the amendment to claim 1 is respectfully requested.

A fee of \$36 is incurred by the addition of two (2) claims in excess of 20. Applicant's check drawn to the order of Commissioner accompanies this Response. Should the check become lost, be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,


Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P56181
Date: 5/19/03
I.D.: REB/ML

MARKED-UP VERSION OF AMENDMENTS SHOWING CHANGES MADE

IN THE CLAIMS

Please amend claim 1 as follows, newly add claims 21-30 by this amendment and cancel claims 3 and 9-15 without prejudice or disclaimer as to their subject matter by this amendment:

1 1. (Amended) A portable memory device for a USB-supporting data processing system, the
2 memory device comprising:

3 a USB connector for being connected to a USB port of the data processing system;

4 an integrated circuit memory for writing/reading data;

5 a connector cover protecting the USB connector from damage, the connector cover capable
6 of sliding automatically backwards upon insertion of the portable memory device into said USB port
7 exposing the USB connector; and

8 a USB interface coupled between the USB connector and the memory, for interfacing the
9 memory with the data processing system.